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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,095	10/04/2005	David Harry Fortune	2308/560	4198
7590	10/31/2008		EXAMINER	
Edwin V Merkel Nixon Peabody Clinton Square P O Box 31051 Rochester, NY 14603-1051				DICKINSON, PAUL W
ART UNIT		PAPER NUMBER		
1618			MAIL DATE	DELIVERY MODE
			10/31/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/552,095	FORTUNE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	PAUL DICKINSON	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 August 2008.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-53 and 63-67 is/are pending in the application.
- 4a) Of the above claim(s) 11,31-53 and 63-67 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 and 12-30 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____ .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

Applicant's arguments, filed 8/8/2008, have been fully considered but they are not deemed to be fully persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objects are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

### ***Response to Arguments***

#### ***Claim Rejections - 35 USC § 112***

The rejection of Claims 8-10 and 12-19 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, is maintained.

Applicant argues that the specification teaches that tissue-reactive materials may be formed by derivatisation of a suitable polymer precursor and the specification further provides examples of polymers and suitable functional groups that may be of used in the derivatisation process.

Applicant's arguments have been fully considered but are not found persuasive. The examples provided are not limiting and "material... formed by derivatization of a polymer precursor" encompasses a myriad of possible species. The structure of a derivative of a polymer precursor may be so far removed from the parent compound as to be a completely different compound. Therefore the specification provides insufficient written description to support the genus of "material... formed by derivatization of a polymer precursor", since there are few representative examples and no reasonable

guidance provided that would allow one of skill in the art to determine what compounds are encompassed by this genus.

***Claim Rejections - 35 USC § 102***

The rejection of Claims 1-10, 12-16, 19-20, and 28-29 under 35 U.S.C. 102(b) as being anticipated by DE 3502998 (DE '998) is maintained.

Applicant argues that DE '998 does not teach or suggest a tissue-adhesive formulation comprising a naturally occurring or synthetic polymerisable and/or cross-linkable material in particulate form and in admixture with particulate material comprising tissue-reactive functional groups. There is no indication that the ferrite particles constitute a polymerisable and/or cross-linkable material. There is no indication of any particular material in admixture with the ferrite particles.

Applicant's arguments have been fully considered but are not found persuasive. In the general teaching, DE '998 discloses ferromagnetic particles combined with a compatible plastic which comprise reactive groups (see page 2, third paragraph). DE '998 specifically discloses ferrite particles in admixture with particles of poly(N-vinyl-2-pyrrolidone-co-acrylic acid) bearing N-hydroxysuccinimide esters (see Example 1). The recitation that an element is "polymerisable and/or cross-linkable" is not a positive limitation but only requires the ability to so perform. Although the reference does not teach that ferrite particles are cross-linkable, the ferrite particles are cross-linkable. For support, the Examiner cites US 6329115 ('115), which teaches cross-linking of ferrite particles (see col 31, lines 13-16).

***Claim Rejections - 35 USC § 103***

The rejection of Claims 1-4, 6-10, and 29-30 under 35 U.S.C. 103(a) as being unpatentable over US 6989192 ('192) is maintained.

Applicant argues that '192 does not teach or suggest a naturally occurring or synthetic polymerisable and/or cross-linkable material in particulate form and in admixture with particulate material comprising tissue-reactive functional groups. '192 teaches blending a pressure sensitive adhesive melt with polymer particles, and not an admixture of a polymerisable and/or cross-linkable material in particulate form with particulate material.

Applicant's arguments have been fully considered but are not found persuasive. The melt taught by '192 is prepared by mixing particles of (a) acrylic acid and methacrylate acid derivatives with particles of (b) vinyl, acrylic and/or methacrylate monomers having a group X. Component (a) corresponds to the synthetic cross-linkable material of Claim 1 and component (b) corresponds to the particulate material comprising tissue-reactive functional groups of Claim 1. The admixture of (a) and (b) is melted, and subsequently blended with crosslinked and functionalized polymer particles. These crosslinked and functionalized polymer particles do not correspond to the particulate material comprising tissue-reactive functional groups of Claim 1.

The rejection of Claims 17-18 and 21 under 35 U.S.C. 103(a) as being unpatentable over DE 3502998 (DE '998) in view of WO 03094898 (WO '898) is

maintained. The rejection of Claims 22 and 30 under 35 U.S.C. 103(a) as being unpatentable over DE 3502998 (DE '998) is maintained.

Applicant argues that WO '898 does not overcome the above-noted limitations of DE '998.

Applicant's arguments have been fully considered but are not found persuasive. As stated above, DE '998 does disclose a tissue-adhesive formulation comprising a naturally occurring or synthetic polymerisable and/or cross-linkable material in particulate form, the polymerisable and/or cross-linkable material being in admixture with particulate material comprising tissue-reactive groups.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL DICKINSON whose telephone number is (571)270-3499. The examiner can normally be reached on Mon-Thurs 9:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Hartley/  
Supervisory Patent Examiner, Art Unit 1618

Paul Dickinson  
Examiner  
AU 1618

October 29, 2008